UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
PATEL, MANGLESH M

ART UNIT	PAPER NUMBER
2178	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

		Application No.	Applicant(s)
Office Action Summary		10/560,876	SCANLAN, PHILIP
		Examiner	Art Unit	
		Manglesh M. Patel	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 January 2007</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____ .

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   This **FINAL** action is responsive to the amendment filed on January 8, 2007.

2.   Claims 1-9 are pending. Claims 1, 6, 7 and 8 are independent claims.

Withdrawn Rejections

3.   The Statutory type double patenting rejection under 35 U.S.C. 101 of claims 1-9 have been withdrawn in

light of the amendment.

4.   The 35 U.S.C. 102 (e) rejections of claims 6 & 8-9 with cited reference of Berstis (U.S. 6,901,367) have

been withdrawn in light of the amendment.

5.   The 35 U.S.C. 103 (a) rejections of claims 1-5 and 7 with cited references of Berstis (U.S. 6,901,367) in view

of Siefert (U.S. 5,778,380) has been withdrawn in light of the amendment.

Double Patenting

6.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public
policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to
exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least
one examined application claim is not patentably distinct from the reference claim(s) because the examined
application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re
Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir.
1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761
(CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome
an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application
or patent either is shown to be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.
        Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal
disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7.   Claims 1-9 are provisionally rejected under the judicially created doctrine of obvious-type double patenting

as being unpatentable over claims 1-9, of co-pending Application No. 10/657555 in view of Boucher (U.S. 5,884,246,

filed Dec 4, 1996). Although the conflicting claims are not identical, they are not patentably distinct from each other

because the two applications describe the automatic translation from a source language to one or more target

languages.

        Regarding independent claims 1, 6, 7 and 8

- Claim 1 ('555, Claim 1);

- Claim 6 ('555, Claim 6);

- Claim 7 ('555, Claim 7);

- Claim 8 ('555, Claim 8);

Claims 2-5 & 9 are same as claims 2-5 & 9 of application '555.

The instant applicant is different in that it claims whereby the electronic communication in the source language is not automatically provided to the user. Boucher discloses that the process of translation is transparent to the recipient of the communication. The recipient is unaware from the message itself that the sender did not originate it in the language in which the recipient received it (see column 10, lines 25-30). Thereby the source language is not provided to the user. Thus, given the claimed invention of '555 and the teachings of Boucher, it would have been obvious to perform automatic language translation without sending the source language to the user. The motivation for doing so would have been to avoid confusion in the language communication by preventing the recipient from receiving the source language.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis (U.S. 6,901,367, filed Jan 28, 1999) in view of Siefert (U.S. 5,778,380 filed on Apr 9, 1997) further in view of Boucher (U.S. 5,884,246, filed Dec 4, 1996).

Regarding Independent claim 1, A method of automatic translation of an electronic communication from a source language to one or more target languages including the steps of: Berstis discloses determining the source language of the electronic communication by identifying a translation identifier or parsing said electronic communication with a language identifier means (fig 3 & column 7, lines 5-67 & column 8, lines 1-67, wherein the source language is determined by a language identifier process when

the function is set to automatic translation); Comparing the target language and source language to determine a required translation (column 7, lines 45-67, wherein when the system is set with automatic translation then a determination is made by comparing the source language with the target language to determine a required translation from the language translation center 311 of figure 3); Obtaining the required translation (fig 3 & column 7, lines 5-67 & column 8, lines 1-67, wherein the translated text and the original communicated text is sent to the output thereby it includes obtaining the translation from the translation center); Berstis fails to explicitly teach a user profile. Siefert teaches determining the target language for the electronic communication by reading a user profile of a user receiving the electronic communication (abstract & column 2, lines 38-60, wherein the invention identifies the language in a text file [source] and translates the language into another language specified by the user, according to a user profile setting); Siefert states in column 10, lines 52-58 that the transformation process is invisible to the user. The procedure of identifying language, and calling a translation program is established by the designer of the system, and does not involve the user. Further stating this invisibility applied to other aspects of the invention, discussed above. Although he mentions that it applies to all aspects of the invention he doesn't explicitly teach that the source data is invisible when received/displayed. However Boucher teaches displaying only the translated electronic communication to the user, whereby the electronic communication in the source language is not automatically provided to the user (column 10, lines 25-30, wherein the process of translation is transparent to the recipient of the communication. The recipient is unaware from the message itself that the sender did not originate in the language in which the recipient received it. Further stating providing such transparent translation is important to many senders of messages to facilitate free communication in their language of choice. A recipient may be less likely to respond to a communication if the recipient knows that the sender must have the response translated or the recipient may be inhibited from responding in the recipients preferred language. Therefore the translation process is seamless because the recipient is unaware of source content of the received message). At the time of the invention it would have been obvious to one of ordinary skill in the art to perform automatic language translation without sending the source language to the user. The motivation for doing so would have been to avoid confusion in the language communication by preventing the recipient from receiving the source language.

Regarding Dependent claim 2, with dependency of claim 1, Berstis discloses a method of automatic translation of an electronic communication according to claim 1 wherein, the translation identifier is a language identifier such as an HTML tag in an HTML document (column 5, lines 60-67 & column 6, lines 1-10, wherein the language identifier includes HTML tags).

Regarding Dependent claim 3, with dependency of claim 1, Berstis discloses a method of automatic translation of an electronic communication: Berstis discloses wherein the translation identifier is a translation information segment (fig 3 & column 7, lines 5-67 & column 8, lines 1-67, wherein the language identification steps include a translation information segment).

Regarding Dependent claim 4, with dependency of claim 1, Berstis discloses a method of automatic translation of an electronic communication according to claim 1, wherein, if there is no translation identifier in said electronic communication, the method comprises the further step of: Parsing the communication with a language identifier software to determine the source language of the communication or obtaining human intervention to identify the source language (figs 3 & 4 & column 7, lines 5-67 & column 8, lines 1-67, wherein the language translation center consists of software algorithm that implements translations from one language to another thereby inherently including the step of parsing the communication).

Regarding Dependent claim 5, with dependency of claim 1, Berstis discloses a method of automatic translation of an electronic communication wherein the step of determining the target language further includes the step of: Although Berstis allows modification set by a user for language translation system, he fails to explicitly teach the use of a user profile. Siefert disclose reading a cookie or a file on a receiving machine to obtain the user profile or obtaining a preference language from a single sign-on system, such as Microsoft Passport. TM. or other information repository (abstract & column 2, lines 38-60). At the time of the invention it would have been obvious to one of ordinary skill in the art to perform automatic language translation without sending the source language to the user. The motivation for doing so would have been to avoid confusion in the language communication by preventing the recipient from receiving the source language.

Regarding Independent claim 6, A seamless translation system comprising:

- An originating computer sending an electronic communication;

- A receiving computer receiving a translated electronic communication;

- A network connecting the originating computer to the receiving computer;

- And a translation manager performing the steps of: automatically determining the language of the electronic communication;

- Automatically determining the preferred language of a user of the receiving computer;

- Obtaining a translation from the language of the communication to the language of the user;

- Sending only the translated communication to the user, whereby the electronic communication in the language of the communication is not automatically provided to the user.

Berstis discloses in column 3, lines 55-67, wherein the communicated data arrives and is processed by the data system thereby including an originating computer & wherein the communicated data arrives and is processed by the data system thereby including a computer for receiving the communication. Further he shows in column 3, lines 55-67, wherein the communicated data arrives and is processed by the data system within a network. And in fig 3 & column 7, lines 5-67 & column 8, lines 1-67, wherein the source language is determined by a language identifier process when the function is set to automatic translation & wherein the language translation center handles the automatic translation including the preferred language of the receiving computer. Also in fig 3 & column 7, lines 5-67 & column 8, lines 1-67, wherein the translated text and the original communicated text is sent to the output thereby it includes obtaining the translation from the translation center. Berstis fails to explicitly teach a user profile. Siefert teaches determining the target language for the electronic communication by reading a user profile of a user receiving the electronic communication (abstract & column 2, lines 38-60, wherein the invention identifies the language in a text file [source] and translates the language into another language specified by the user, according to a user profile setting); Siefert states in column 10, lines 52-58 that the transformation process is invisible to the user. The procedure of identifying language, and calling a translation program is established by the designer of the system, and does not involve the user. Further stating this invisibility applied to other aspects of the invention, discussed above. Although he mentions that it applies to all aspects of the invention he doesn't explicitly teach that the source data is invisible when received/displayed. However Boucher states in column 10, lines 25-30, wherein the process of translation is transparent to the recipient of the communication. The

recipient is unaware from the message itself that the sender did not originate in the language in which the recipient received it. Further stating providing such transparent translation is important to many senders of messages to facilitate free communication in their language of choice. A recipient may be less likely to respond to a communication if the recipient knows that the sender must have the response translated or the recipient may be inhibited from responding in the recipients preferred language. Therefore the translation process is seamless because the recipient is unaware of source content of the received message. At the time of the invention it would have been obvious to one of ordinary skill in the art to perform automatic language translation without sending the source language to the user. The motivation for doing so would have been to avoid confusion in the language communication by preventing the recipient from receiving the source language.

Regarding Independent claim 7, Berstis discloses a seamless translation system comprising: An electronic communication originating from a source and in a source language containing a translation identifier (fig 3 & column 7, lines 5-67 & column 8, lines 1-67); And a translation manager including means for determining the source language and a target language of said electronic communication <u>and means for sending only the translated communication to a user, whereby the electronic communication in the source language is not automatically provided to the user</u> (column 7, lines 45-67, wherein when the system is set with automatic translation then a determination is made by comparing the source language with the target language to determine a required translation from the language translation center 311 of figure 3); Wherein the translation manager executes a required translation of said source language to said target language using the translation identifier and the user profile (fig 3 & column 7, lines 5-67 & column 8, lines 1-67, wherein the translation center performs the translation using the translation identifier). Berstis fails to explicitly teach a user profile. Siefert teaches a user profile (abstract & column 2, lines 38-60, wherein the invention identifies the language in a text file [source] and translates the language into another language specified by the user, according to a user profile setting); Siefert states in column 10, lines 52-58 that the transformation process is invisible to the user. The procedure of identifying language, and calling a translation program is established by the designer of the system, and does not involve the user. Further stating this invisibility applied to other aspects of the invention, discussed above. Although he mentions that it applies to all aspects of the invention he doesn't explicitly teach that the source data is invisible when received/displayed. However Boucher states in column 10, lines 25-30, wherein the process of translation is transparent to the

recipient of the communication. The recipient is unaware from the message itself that the sender did not originate in the language in which the recipient received it. Further stating providing such transparent translation is important to many senders of messages to facilitate free communication in their language of choice. A recipient may be less likely to respond to a communication if the recipient knows that the sender must have the response translated or the recipient may be inhibited from responding in the recipients preferred language. Therefore the translation process is seamless because the recipient is unaware of source content of the received message. At the time of the invention it would have been obvious to one of ordinary skill in the art to perform automatic language translation without sending the source language to the user. The motivation for doing so would have been to avoid confusion in the language communication by preventing the recipient from receiving the source language.

Regarding Independent claim 8, Berstis discloses a seamless translation system comprising:

- An originating computer sending an electronic communication (column 3, lines 55-67, wherein the communicated data arrives and is processed by the data system thereby including an originating computer);
- A receiving computer receiving a translated electronic communication (column 3, lines 55-67, wherein the communicated data arrives and is processed by the data system thereby including a computer to receive the communication);
- A network connecting the originating computer to the receiving computer (column 3, lines 55-67, wherein the communicated data arrives and is processed by the data system within a network);
- Automatic means for determining the language of the electronic communication (fig 3 & column 7, lines 5-67 & column 8, lines 1-67, wherein the language translation center handles the automatic translation including the preferred language of the receiving computer);
- Automatic means for determining the preferred language of a user of the receiving computer (fig 3 & column 7, lines 5-67 & column 8, lines 1-67, wherein the language translation center handles the automatic translation including the preferred language of the receiving computer);
- Means for obtaining a translation from the language of the communication to the language of the user (fig 3 & column 7, lines 5-67 & column 8, lines 1-67, wherein the translated text and the original communicated text is sent to the output thereby it includes obtaining the translation from the translation center);

- Means for sending <u>only</u> the translated electronic communication to the user, <u>whereby the electronic communication in the language of the electronic communication is not automatically provided to the user</u> (fig 3 & column 7, lines 5-67 & column 8, lines 1-67, wherein the translated text is sent to the user). Berstis fails to explicitly teach a user profile. Siefert teaches a user profile (abstract & column 2, lines 38-60, wherein the invention identifies the language in a text file [source] and translates the language into another language specified by the user, according to a user profile setting); Siefert states in column 10, lines 52-58 that the transformation process is invisible to the user. The procedure of identifying language, and calling a translation program is established by the designer of the system, and does not involve the user. Further stating this invisibility applied to other aspects of the invention, discussed above. Although he mentions that it applies to all aspects of the invention he doesn't explicitly teach that the source data is invisible when received/displayed. However Boucher states in column 10, lines 25-30, wherein the process of translation is transparent to the recipient of the communication. The recipient is unaware from the message itself that the sender did not originate in the language in which the recipient received it. Further stating providing such transparent translation is important to many senders of messages to facilitate free communication in their language of choice. A recipient may be less likely to respond to a communication if the recipient knows that the sender must have the response translated or the recipient may be inhibited from responding in the recipients preferred language. Therefore the translation process is seamless because the recipient is unaware of source content of the received message. At the time of the invention it would have been obvious to one of ordinary skill in the art to perform automatic language translation without sending the source language to the user. The motivation for doing so would have been to avoid confusion in the language communication by preventing the recipient from receiving the source language.

Regarding Dependent claim 9, with dependency of claim 8, Berstis discloses a seamless translation system comprising a translation manager, said translation manager including:

- Said automatic means for determining the language of the electronic communication (column 7, lines 45-67, wherein when the system is set with automatic translation then a determination is made by comparing the source language with the target language to determine a required translation from the language translation center 311 of figure 3);

- Said automatic means for determining the preferred language of a user of the receiving computer (column 7, lines 45-67, wherein when the system is set with automatic translation then a determination is made by comparing the source language with the target language to determine a required translation from the language translation center 311 of figure 3);

- Said means for obtaining a translation from the language of the communication to the language of the user (fig 3 & column 7, lines 5-67 & column 8, lines 1-67, wherein the language translation center handles the translation from the communication to the user language);

- Said means for sending only the translated electronic communication to the user (fig 3 & column 7, lines 5-67 & column 8, lines 1-67, wherein the translated communication is sent to the user from the translation center). Berstis fails to explicitly teach a user profile. Siefert teaches a user profile (abstract & column 2, lines 38-60, wherein the invention identifies the language in a text file [source] and translates the language into another language specified by the user, according to a user profile setting); Siefert states in column 10, lines 52-58 that the transformation process is invisible to the user. The procedure of identifying language, and calling a translation program is established by the designer of the system, and does not involve the user. Further stating this invisibility applied to other aspects of the invention, discussed above. Although he mentions that it applies to all aspects of the invention he doesn't explicitly teach that the source data is invisible when received/displayed. However Boucher states in column 10, lines 25-30, wherein the process of translation is transparent to the recipient of the communication. The recipient is unaware from the message itself that the sender did not originate in the language in which the recipient received it. Further stating providing such transparent translation is important to many senders of messages to facilitate free communication in their language of choice. A recipient may be less likely to respond to a communication if the recipient knows that the sender must have the response translated or the recipient may be inhibited from responding in the recipients preferred language. Therefore the translation process is seamless because the recipient is unaware of source content of the received message. At the time of the invention it would have been obvious to one of ordinary skill in the art to perform automatic language translation without sending the source language to the user. The motivation for doing so would have been to avoid confusion in the language communication by preventing the recipient from receiving the source language.

It is noted that any citation [[s]] to specific, pages, columns, lines, or figures in the prior art

references and any interpretation of the references should not be considered to be limiting in any way.

A reference is relevant for all it contains and may be relied upon for all that it would have reasonably

suggested to one having ordinary skill in the art. [[See, MPEP 2123]]

Response to Arguments

10.   Applicant's arguments filed January 8, 2007 have been fully considered but are moot in view of the newly

cited art and amended claims.

Conclusion

11.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing

date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and

the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory

period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed

to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M,F

8:30-6:00 T,TH 8:30-3:00 Wed 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S.

Hong can be reached on (571)272-4124. The fax phone number for the organization where this application or

proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information

Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or

Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more

information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the

Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manglesh M. Patel
Patent Examiner
March 27, 2007

CESAR PAULA
PRIMARY EXAMINER